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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,516	11/12/2003	William John Gallagher	BEAS-1316US2	7688
23910	7590	06/22/2006	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			NGUYEN, PHILLIP H	
			ART UNIT	PAPER NUMBER
			2194	

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/706,516	GALLAGHER, WILLIAM JOHN	
Examiner	Art Unit		
Phillip H. Nguyen	2194		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 12 November 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-11 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-11 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 12 November 2003 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_ .  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04212006 10122004.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

## **DETAILED ACTION**

1. This action is in response to the original filing of November 12, 2003. Claim 1-11 are pending and have been considered below.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

In paragraph [0014], the applicant must defined EJBs, JDBC, and API in paragraph [0015]. For examining purposes, the examiner interprets API as *Application Program Interface*, EJBs as *Enterprise JavaBeans*, and JDBC as *Java Database Connectivity*.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It is directed to software, *per se*, lacking storage on a medium, which enables any underlying functionality to occur. Additional items to consider are whether the instructions are necessarily in executable form and whether their execution accomplishes a practical application, i.e., produces a useful, concrete and tangible result. Even if they are executable and produce a practical

application, there is the additional question of whether it is an attempt to claim every substantial practical application of an abstract idea and thus raise an issue of preemption.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1, 8, and 9 contain the trademark or trade name Java. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark or trade name is used to identify or describe a family of products generated in the proprietary programming language called Java and accordingly, the identification or description is indefinite.

***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-11 provisionally rejected on the ground of nonstatutory double patenting over claims 1-11 of copending Application No. 10/706,516. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The system discloses in claims 1-11 needs to have a method discloses in copending Application No. 10/712,384 in order to automatically generate program code. Likewise, the method discloses in copending Application No. 10/712,384 needs to run on a system for automatically generating program code. Therefore, it would be obvious to combine the method and the system together to automatically generating program code.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Stapp et al. (09/866,131).

Claim 1: Stapp discloses a computer program product for automatically generating program code, comprising:

- a. Computer code for creating a class file container object ([0024-027]);
- b. Computer code for adding a method to the class file object ([0027]);
- c. Computer code for adding code to the method ([0027]);
- d. Computer code for generating Java byte code for the class file container object ([0036-0037]); and
- e. Computer code for generating an instance of the new class file object ([0030]).

Claim 2: Stapp discloses a computer program product for automatically generating program code as in claim 1 above, and further discloses wherein creating a class file container object includes: setting attributes for a class file ([0032]).

Claim 3: Stapp discloses a computer program product in claim 2 above, and further discloses the attributes include at least one of class file name, parent super ([0033]).

Claim 4: Stapp discloses a computer program product for automatically generating program code as in claim 1 above, and further discloses wherein adding a method to the class file object includes: adding a plurality of methods to the class file object ([0027]).

Claim 5: Stapp discloses a computer program product for automatically generating program codes as in claim 1 above, and further discloses wherein adding code to the method includes adding code to the method using constructs that correspond to programming language statements, expressions, and variables ([0027], [0034]).

Claim 6: Stapp discloses a computer program product in claim 5 above, and further discloses constructs include parameters ([0028]).

Claim 7: Stapp discloses a computer program product in claim 5 above, and further discloses wherein each statement, expression type, variable is represented as an object ([0026-0027]).

Claim 8: Stapp discloses a computer program product for automatically generating program code as in claim 1 above, and further discloses wherein generating Java byte code for the class file container object includes generating an intermediate representation of program flow ([0034-0037]).

Claim 9: Stapp discloses a computer program product in claim 8 above, and further discloses wherein generating Java byte code for the class file container object includes converting the intermediate representation into byte code ([0034-0037]).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stapp (09/866,131) in view of Goodwin (US 6,199,195).

Claim 10: Stapp discloses a computer program product for automatically generating program code as in claim 1 above, but does not explicitly disclose that the program code implements an adaptor class. However, Goodwin discloses the program code implements an adapter class (Fig. 3, item 310, 312). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add an adapter class in Stapp to take the place of some class and expose it through a different interface. One would have been motivated to use an adapter class when creating a reusable class that cooperates with other classes that have incompatible interfaces. Or when separating the client interface of an object from its implementation so each can evolve independently. Or when converting the interface of a class into another interfaces that the clients expect.

Claim 11: Stapp discloses a computer program product for automatically generating program code as in claim 1 above, but does not explicitly disclose that the program code implement a proxy class. However, Goodwin discloses the program code implements a proxy class (Fig. 3, item 318). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a proxy class in Stapp to enforce call-by-value semantics between Enterprise JavaBeans (EJBs). One would have been motivated to use proxy class to reduce system development time, compile and build time, and system modification time.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

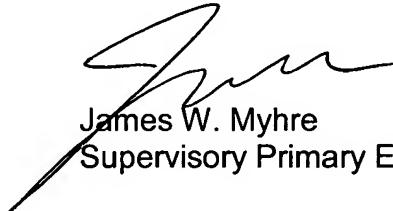
a. Taylor (US 2004/0019596 A1) discloses method, system, and program for making objects available for access to a client over a network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip H. Nguyen whose telephone number is (571) 270-1070. The examiner can normally be reached on Monday - Friday 8:30 AM - 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on (571) 270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PN  
5/18/2006



James W. Myhre  
Supervisory Primary Examiner